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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,321	05/09/2005	Nigel D Young	GB 020187	4904

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BRIARCLIFF MANOR, NY 10510

EXAMINER

HOLLWEG, THOMAS A

ART UNIT

PAPER NUMBER

2879

MAIL DATE

DELIVERY MODE

11/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/534,321	Applicant(s) YOUNG, NIGEL D
Examiner Thomas A. Hollweg	Art Unit 2879

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/NIMESHKUMAR D. PATEL/
Supervisory Patent Examiner, Art Unit 2879

Continuation of 11, does NOT place the application in condition for allowance because:

1. The amendments to the drawings are not accepted. The edits to figures 5D and 5E make these figures inconsistent with figure 4 with regard to contact region 19-1. The examiner believes that the original error was in figures 6 and 7 where the recess should have been labeled 22 instead of 21.
2. Applicant's arguments regarding the finality of the Office Action of August 18, 2008, have been considered but are not found to be persuasive. Applicant argues that because an English translation of the Japanese reference, 2002-313572, was not included with the first Office Action, of January 9, 2008, that the Office Action of August 18, 2008, could not have been made final. Applicant relies on MPEP § 706.02 and case law; Ex parte Jones, (62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) and Ex parte Shade (Appeal No. 2001-1241).
3. MPEP § 706.02 obligates the Office to provide an English translation of a document that is a language other than English where the examiner seeks to rely on that document for a prior art rejection and where the document is "[p]rior art uncovered in searching the claimed subject matter of a patent application." (MPEP 706.02, II, first sentence) (emphasis added).
4. In the present case Japanese reference, 2002-313572, was provided to the examiner in an Information Disclosure Statement (IDS) submitted by the applicant on September 25, 2006. The submission included a Japanese-language copy of reference 2002-313572. There is an expectation that the applicant had knowledge of the scope of the reference since the citation in the IDS implies that the applicant considered the reference material to the examination of the application. This expectation is supported by 37 C.F.R. 1.98, which in section (a)(3) states that an IDS shall include: "(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein. (ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c)." Where a reference is introduced into the record by the applicant in an IDS, and is not introduced by the examiner through searching the claimed subject matter, the Office is not obligated to provide a translation of the reference.
5. In Ex parte Jones the examiner relied on an English-language abstract of a non-English-language reference in formulating a 35 U.S.C. § 103(c) rejection, without referring to translations of the underlying documents. Unlike the examiner in Ex parte Jones, in the first Office Action of January 9, 2008, the examiner relied on an English-language translation of a non-English-language reference supplied by the applicant in formulating 35 U.S.C. § 102(b) rejection of claims 1, 6-9, 16 and 17.
6. The examiner was unable to obtain a copy of Ex parte Shade, however, this case is also not applicable to the present case. According to the quotation of Ex parte Shade, provided by the applicant in footnote 1 of Remarks/Discussion of Issues, the examiner in that case relied on a foreign-language document. As previously stated, the first Office Action, the examiner relied on an English-language translation of the foreign document, which is a "much more reliable basis for a prior art rejection," according to the court in Ex parte Shade.
7. As a courtesy, a translation of Japanese reference, 2002-313572, was included in the Final Office Action of August 18, 2008. Contrary to applicant's suggestion, the translation provided is complete, and includes all 19 paragraphs of the original document. Applicant may confirm this by comparing the translation provided with the Japanese-language reference that applicant submitted on September 25, 2006.
8. Assuming arguendo that MPEP 706.02 obligates the Office to provide a full text English-language translation of Japanese reference. It is unclear from the applicant's arguments why a failure to supply the translation with the first Office Action is a basis for preventing the next Office Action from being final. According to the last two sentences of MPEP 706.02, II., "the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a)." MPEP § 706.07(a) does not support the assertion that a second Office Action may not be made final where a translation of a non-English language reference is not included with the first Office Action. Therefore, finality of the Office Action of August 18, 2008, will not be withdrawn.
9. With regard to applicant's arguments concerning the 35 U.S.C. 102(b) rejection of claims 1 and 9, the applicant points to a typographical error in the rejection of claim 1 in the Office Action, where the conductive region is first referred to as (31b) and then errantly referred to as (32b). The references to elements in the figures of the prior art references are included for clarity. The prior art, Japanese reference, 2002-313572, anticipates applicant's claim, as clearly shown in figure 2 and described in the prior art document, an English-language translation of which was provided with the Office Action.
10. Further, the Office Action does not assert that "the anode 32b and the negative pole 33a are in electrical connection through layer 31a." The Office Action states, on page 6, that "the second overlying electrode layer (33a) and the underlying conductive region (32b) [are] in electrical connection through the thickness of the organic light emissive material (32a)." As stated above, the conductive region was mislabeled. It should have been labeled (31b) as it is referred to throughout the remainder of the Office Action.
11. The remainder of applicant's arguments are not understood because there is no reference to anode 32b in either the prior art reference or the Office Action. Layer 32b is an electroluminescent layer [0012] (JP, 2002-313572). Therefore, all prior art rejections remain.